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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,304	01/16/2002	Tim Mathiesen	EAIP002	8736

7590

03/24/2006

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/050,304	MATHIESEN ET AL.	
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-5, 7-11, 13-15, 17-22, 24-29, 31-34, 36-43, 45-49, and 51-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Melo et al. (US 2001/0037270 A1) and Manglapus et al. (Ser. No. 09/138,962; now US Patent No. 6,219,151) as incorporated by reference in Melo (Para 0023).**
3. As per **independent Claims 1, 13, 24, 36, and 45**, Melo discloses a method of providing a printing system under a lease agreement, comprising: leasing out a server computer (Para 0020, printer network connection / proxy server would be part of printer lease), wherein the server computer receives a digital image transmitted from a computer system (Usage data received from user / user work station; Manglapus: abstract Figs.1-9); leasing out at least one printer connected to the server computer (Para 0013), wherein the at least one printer prints the digital image (Para 0017, image data); and providing a remote monitoring server (Para 0019-0020), having a connection with the server computer (Para 0020), to monitor conditions of at least one of the server computer and

the at least one printer, wherein the remote monitoring system is operated by a lessor (Para 0012-0013, finance company/dealer/service can be performed by same entity).

4. As per Claims 2, 17, 25, 37, and 46, Melo discloses connecting an input device to the computer system to provide the digital image to the computer system (Manglapus: user work station, abstract Figs.1-9).
5. As per Claims 3, 26, 38, and 47, Melo discloses wherein the input device is selected from the group consisting of a scanner, a digital camera, *a computer system, and a network* (Manglapus: abstract Figs.1-9).
6. As per Claims 4, 14, 28, and 48, Melo discloses providing a storage device within the computer system to store the digital image (Manglapus: Fig.4, Data in Memory).
7. As per Claims 5, 15, 29, and 49, Melo discloses providing software to the computer system to edit the digital image (Manglapus: Part of creating “print job” – would include enlarge, reduce, tone, # of copies, etc.).
8. As per Claims 7, 18, 31, 40, and 51, Melo discloses providing updates by the remote monitoring server for software on the server computer (Para 0022, Billing Party transmit).
9. As per Claims 8, 19, 32, 41, and 52, Melo discloses servicing at least one of the server computer and the at least one printer based on the conditions monitored by the remote monitoring server (Para 0031).
10. As per Claims 9, 20, 33, 42, and 53, Melo discloses maintaining an account based on the conditions monitored by the remote monitoring server (Usage monitored and tracked for billing purposes, Para 0027-0029, Claim 5).

11. As per Claims 10, 21, 34, 43, and 54, Melo discloses wherein the conditions monitored include at least one of a number of media printed by the at least one printer, a status of the server computer, a status of the at least one printer, and an ink level of an ink cartridge in the at least one printer (Para 0031, Service).
12. As per Claims 11, 22, and 55, Melo discloses supplying at least one of ink and print media based on the conditions monitored by the remote monitoring server (Para 0031, Service).
13. As per Claims 27 and 39, Melo discloses wherein the computer system and the server computer reside within a single system (Printing network disclosed by Melo and Manglapus).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
15. **Claims 6, 16, 30, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melo in view of Official Notice.**
16. As per Claims 6, 16, 30, and 50, while Melo does not explicitly disclose converting the digital image into a proprietary format prior to transmitting the digital image to the server computer, Official Notice is taken that converting files to “Read Only” format

(converting the digital image into a proprietary format) prior to release of information, was a common method of securing data in use with the disclosed printing functionality at the time the invention was made.

17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the user with the ability to secure the data before sending the print job, to increase user security and guard against property theft and piracy.

18. Claims 12, 23, 35, 44, and 56 are rejected under 35 U.S.C. 103 as being unpatentable over Melo.

19. As per Claim 12, 23, 35, 44, and 56, Melo discloses wherein the lease agreement covers pre-established billing contract rules, and supply of ink and print media to the end user by the lessor (Para 0031-0034, Service Agreements and pre-established billing contract rules).

20. However, Melo fails to expressly disclose wherein the lease agreement covers possession and minimum use of the server computer and the at least one printer by an end user.

21. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The Printer leasing system would be performed regardless of the type of lease Agreement established. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a leasing agreement that covers possession and minimum use

of the server computer and the at least one printer by an end user, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

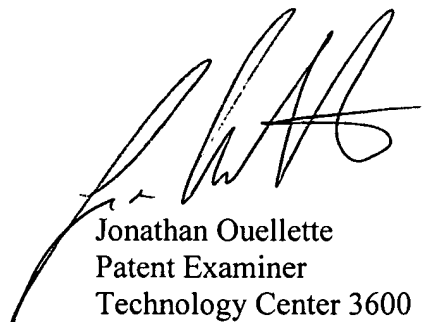
Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
24. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

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March 16, 2006



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